

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)	
)	
Inventor: Lee Anne Kowalski)	Examiner: Henry W. Orr
)	
Serial #: 09/928,599)	Group Art Unit: 2176
)	
Filed: August 13, 2001)	Appeal No.: _____
)	
Title: METHOD AND SYSTEM FOR)	
IDENTIFYING AND DISTINGUISHING)	
WORDS CONTAINED WITHIN AN)	
ELECTRONIC MESSAGE IN ORDER TO)	
CONVEY SIGNIFICANCE)	

REPLY BRIEF OF APPELLANT

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In accordance with 37 C.F.R. §41.41, Appellant's attorney hereby submits the Reply Brief of Appellant in response to the Examiner's Answer dated May 11, 2009 for the above-identified application.

No fee is required for filing this Reply Brief of Appellant. However, the Office is authorized to charge any necessary fees or credit any overpayments to Deposit Account No. 09-0460 of IBM Corporation, the assignee of the present application.

I. ARGUMENTS

In the Answer, the Examiner essentially reiterates the prior rejections, albeit with additional remarks. In this regard, this Reply Brief of Appellant incorporates by reference herein the entirety of the previously filed Brief of Appellant. Moreover, additional arguments are also presented below.

A. Arguments directed to the first grounds for rejection: Claims 1, 4-16, 19-23, 26-38, 41-45, 48-60, and 63-66 stand rejected under 35 U.S.C. §103(a) as being obvious over Padwick et al., “Special Edition Using Microsoft Outlook 2000 .” Que Publishing, May 12, 1999 (Padwick-Outlook 2000) in view of Chen et al., U.S. Patent No. 6,009,442 (Chen).

1. Independent claims 1, 23 and 45

Appellant’s invention, as recited in independent claim 1, is patentable over the combination of Padwick-Outlook 2000 and Chen, because independent claim 1 recites limitations not found in the Padwick-Outlook 2000 and Chen references.

Nonetheless, in response to the arguments in the Brief of Appellant, the Examiner’s Answer states the following beginning at page 24:

(10) Response to Argument
Independent claims 1, 23 and 45

Appellant notes that the rejections based on Padwick-Outlook 2000 and Chen were last presented in the Office Action dated November 29, 2005, were previously overcome in the response filed by the Appellant dated February 27, 2006, as acknowledged by the rejections’ absence in the Office Action dated April 25, 2006. (See Brief Response page 16)

Examiner respectfully disagrees.

Examiner submits that changing the combination of references from Padwick-Outlook 2000 and Chen to Padwick-Outlook 2002 and Chen does not explicitly acknowledge that the Appellant has overcome the Padwick-Outlook 2000 and Chen references. Examiner notes that the subject matter previously relied upon in Padwick, Outlook 2002 in Action dated 11/13/2007 before being eliminated by Appellant’s submission of Declarations under 37 C.F.R. 1.131 is substantially the same subject matter relied upon in Padwick, Outlook 2000. Therefore, in respect to the relied upon subject matter, Padwick-Outlook 2000 and Padwick-Outlook 2002 are interchangeable. Thus, Examiner has never explicitly or implicitly acknowledged that the Appellant has sufficiently overcome the applied rejections based on Padwick-Outlook 2000 and Chen.

Appellant argues that the combination of Padwick-Outlook 2000 and Chen fail to teach or suggest making alterations to the electronic message to identify the matched message terms and to indicate their significance to a reader, wherein the alterations are made by an electronic messaging application when the electronic message is authored by its originator or received by its recipient. Chen explicitly states that emails or other documents must be imported into its document management system. See, col. 3, 37-59 of Chen. Moreover, Chen’s document management system is not an electronic messaging application. Consequently, Chen does not make the alterations when the electronic message is authored by its originator or received by its recipient. Instead, Chen teaches functions that are

performed only when the email has been imported into the document management system (See Brief Response p. 16-17).

Examiner respectfully disagrees.

Chen explicitly recites “A category is a logical grouping of documents that share some common attribute or attributes, sometimes referred to as category criteria. For example, a category may consist of a number of documents that share a common author, a number of documents that contain at least a predefined number of words, a number of documents that contain certain key words, or a number of documents that share a common concept” (see col. 7 lines 5-15). (emphasis added)

Chen explicitly recites “The document viewing utility 169 also highlights category criteria. In other words, its highlights the various keywords, phrases, and/or attributes in the document being viewed, which make up the category criteria, assuming, of course, the document has been categorized” (see col. 15 lines 22-26). In light of the two passages above, Chen does teach making alterations (e.g. highlighting keywords) to the electronic message (i.e., document) to identify the matched message terms (i.e., matched keywords found in both category criteria and document are highlighted or identified in the document) and to indicate their significance to a reader, (i.e., highlighted keywords of the document indicate significance of the category criteria to a reader) wherein the alterations are made by an electronic messaging application (i.e., highlighting is made by the document management system) when the electronic message is authored by its originator (Examiner notes that all documents are authored by an originator, therefore this particular limitation reads on all documents) or received by its recipient (Examiner notes that the person using the utility to view document may be its recipient). Appellant alleges that Chen’s document management system is not an electronic messaging application. However, Chen’s document management system is capable of performing the functions of the claimed “electronic messaging application.” For example, Chen’s document management system is also capable of sending documents as emails (see col. 9 lines 10-12, col. 12 lines 4-10). Therefore, the claimed “electronic messaging application” is not patentably distinguishable over Chen’s document management system.

Appellant’s attorney disagrees with this analysis.

With regard to the previous rejections based on Padwick-Outlook 2000 and Chen, Appellant’s attorney merely notes the following timeline:

1. In an Office Action dated November 29, 2005, claims 1-16, 19-38, 41-60, and 63-66 were rejected under 35 U.S.C. § 103(a) as being unpatentable over “Special Edition Using Microsoft Outlook 2000” (Padwick-Outlook 2000) in view of U.S. Patent No. 6,009,442 (Chen).
2. In a response dated February 27, 2006, Appellant’s attorney amended the claims and argued against the rejections based on Padwick-Outlook 2000 and Chen.

3. Subsequently, in an Office Action dated April 26, 2006, there were no rejections based on Padwick-Outlook 2000 and Chen.
4. Moreover, there were subsequent Office Actions dated October 5, 2006, June 20, 2007, and November 13, 2007, in which there were no rejections based on Padwick-Outlook 2000 and Chen.
5. Thereafter, in an Office Action dated April 15, 2008, the rejections based on Padwick-Outlook 2000 and Chen were reintroduced.

Even though the Examiner's Answer asserts that the "Examiner has never explicitly or implicitly acknowledged that the Appellant has sufficiently overcome the applied rejections based on Padwick-Outlook 2000 and Chen," the record speaks for itself. The Examiner withdrew the rejections based on the Padwick-Outlook 2000 and Chen references in response to Appellant's response dated February 26, 2007, and then, after three intervening Office Actions, reintroduced the rejections based on the Padwick-Outlook 2000 and Chen references in the Office Action dated April 15, 2008.

Appellant's attorney respectfully submits that the earlier conclusion by the Examiner was correct, namely, that Appellant's claimed invention distinguishes over the combination of Padwick-Outlook 2000 and Chen. Specifically, Appellant's attorney respectfully submits that the combination of Padwick-Outlook 2000 and Chen does not teach or suggest making alterations to the electronic message to identify the matched message terms and to indicate their significance to a reader, wherein the alterations are made by an electronic messaging application when the electronic message is authored by its originator or received by its recipient.

For example, the Office Action acknowledges that Padwick-Outlook 2000 fails to disclose making alterations to the electronic message to identify the matched message terms and to indicate their significance to a reader. Nonetheless, the Office Action asserts that Chen teaches these limitations. Further, the Office Action asserts that Chen teaches altering the electronic message when it is authored or received.

However, Chen explicitly states that emails or other documents must be imported into its document management system. Moreover, Chen's document management system is not an electronic messaging application. Consequently, Chen does not make alterations to an electronic message when the electronic message is authored by its originator or received by its recipient.

Instead, Chen teaches functions that are performed only when an electronic message has been imported into the document management system.

The Examiner's Answer essentially reads the limitation "when the electronic message is authored by its originator or received by its recipient" out of the claims, when it asserts that "all documents are authored by an originator, therefore this particular limitation reads on all documents," and when it asserts that "the person using the utility to view document may be its recipient."

In normal usage, for example, as defined by the Merriam-Webster dictionary, the word "when" is defined as "at what time" or "at or during which time." Consequently, the use of the word "when" in Appellant's claims requires that alterations be made to the electronic message when ("at the time") the electronic message is authored by its originator or received by its recipient. This is not shown by Chen (or by Padwick-Outlook 2000). Instead, Chen teaches functions that are performed only when a document has been imported into the document management system.

The citation by the Examiner's Answer to the email functions in Chen fails to overcome these deficiencies. Consider the following portions of Chen, which comprise portions of Chen cited by the Examiner's Answer as well as other pertinent portions of Chen:

Chen: col. 7, lines 4-40

CATEGORIES AND CATEGORIZATION OF DOCUMENTS

The present invention also employs a categorization utility 159 that provides different levels of automated assistance in organizing the document collection. A category is a logical grouping of documents that share some common attribute or attributes, sometimes referred to as category criteria. For example, a category may consist of a number of documents that share a common author, a number of documents that contain at least a predefined number of words, a number of documents that contain certain key words, or a number of documents that share a common concept. A more specific example might be a category called "company press releases" or a category called "all e-mails I've sent out". Categories can also be defined hierarchically. In other words, a category may have a subcategory. For example, "all e-mails I've sent out to my group" might be a subcategory of "all e-mails I've sent out".

The categorization utility 159 implements a category by associating a corresponding set of category criteria with a folder in the document collection hierarchy; however, it will be recognized that not every folder in the document collection hierarchy is associated with a category. For example, in FIG. 3, folder F.sub.2 is associated with a category as indicated by the symbol "*". However, folders F.sub.1, F.sub.3 and F.sub.4 are not associated with a category.

Folders that are associated with a category are, in general, referred to herein as “smart” folders. They are referred to as smart folders because the categorization utility 159 continuously searches through the STG file directory, or a portion thereof, for documents that match the category criteria associated with each smart folder. If a match is identified, the categorization utility 159 generates a link between the smart folder and the matching document, through the matching document’s STG file, thus creating the appearance that smart folders automatically collect matching documents without user interaction.

Chen: col. 9, lines 5-15

Smart folders can also be reactive. In accordance with a preferred embodiment of the present invention, a user can program a smart folder with particular behavioral characteristics, such that a particular task or tasks are automatically performed on or with the documents linked with that smart folder. **For example, the user may program a smart folder to automatically e-mail all documents stored therein to a particular e-mail address.** In another example, the user may program a smart folder to periodically display folder updates, such as the addition or deletion of new documents.

Chen: col. 11, lines 24-37

BROWSING DOCUMENTS

The present invention includes a document browsing utility 163. The Browser utility 163 permits the user to quickly and efficiently review the document collection or a portion thereof. Moreover, it allows the user to view the documents and the document categories as they are logically arranged in the organizational tree described above. In addition, **the Browser utility 163 permits the user to manipulate documents and document categories; to copy, move and delete documents and document categories; to view and print documents; and to bundle multiple documents into a compound document entity referred to as a clipped document.** Clipped documents are described in greater detail below.

Chen: col. 12, lines 1-17

These two user interfaces associated with the Browser utility 163, My Computer, as illustrated in FIG. 10, and Explorer, as illustrated in FIG. 11, each have a number of standard pull-down menus. **The FILE pull-down menu, for example, allows the user to, among other options, open documents, clipped documents, or document categories; send documents or clipped documents as e-mail messages; create new categories; import new documents from the scanner; delete, rename and/or list the properties of documents, clipped documents and categories.** The EDIT menu allows the user to copy, paste, select all or part of a document. This menu also allows the user to clip or unclip documents. The VIEW menu, among other options, allows the user to display a customizable application toolbar, to be described below, and to control the arrangement and display representation of each document. In addition, there is also a TOOLS, TEST and a HELP menu.

The above portions of Chen describe functions that are performed after a document is imported into its document management system.

In one aspect of Chen, a document imported into the system may be categorized, which generates a link between a smart folder associated with the category and the document. A task is automatically performed on or with the documents linked with the smart folder, such as automatically e-mailing the document to a particular e-mail address. However, such a task does not teach or suggest Appellant's claimed invention of making alterations to an electronic message when ("at the time") the electronic message is authored by its originator or received by its recipient.

In another aspect of Chen, a document imported into the system may be browsed using a Browser utility, which allows a user to view the document. In addition, a "File" pull-down menu of the Browser utility allows the user to send the document as an email message. However, such a function does not make alterations to an electronic message when ("at the time") the electronic message is authored by its originator or received by its recipient.

Consequently, in neither aspect does Chen teach or suggest the limitations of Appellant's independent claims 1, 23 and 45.

Larson fails to overcome the deficiencies of Padwick-Outlook 2000 and Chen. Recall that Larson was cited only against dependent claims 17-18, 39-40, and 61-62, and only for teaching a telephone access system that inserts an audio file at a highlighted term of an electronic message.

Thus, even when combined, the references do not teach or suggest all the limitations of Appellant's claims. Moreover, the various elements of Appellant's claimed invention together provide operational advantages over the references. In addition, Appellant's invention solves problems not recognized by the references.

As a result, Appellant's attorney submits that independent claims 1, 23 and 45 are allowable over Padwick-Outlook 2000 and Chen. Further, dependent claims 4-22, 26-44 and 48-66 are submitted to be allowable over Padwick-Outlook 2000, Chen and/or Larson in the same manner, because they are dependent on independent claims 1, 23, and 45, respectively, and thus, contain all the limitations of the independent claims. In addition, dependent claims 4-22, 26-44

and 48-66 recite additional novel elements not shown by Padwick-Outlook 2000 , Chen and/or Larson.

II. CONCLUSION

In light of the above arguments, Appellant's attorney respectfully submits that the cited references do not anticipate nor render obvious the claimed invention. More specifically, Appellant's claims recite novel physical features which patentably distinguish over any and all references under 35 U.S.C. §§ 102 and 103.

As a result, a decision by the Board of Patent Appeals and Interferences reversing the Examiner and directing allowance of the pending claims in the subject application is respectfully solicited.

Respectfully submitted,

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